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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/447,297	11/23/1999	SATOSHI KAJITA	01413/FP-469	3644

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WENDEROTH LIND & PONACK LLP
2033 K STREET NW
SUITE 800
WASHINGTON, DC 20006

EXAMINER

BOUTAH, ALINA A

ART UNIT	PAPER NUMBER
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2143

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DATE MAILED: 09/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/447,297

Applicant(s)

KAJITA ET AL.

Examiner

Alina N Boutah

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 July 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____. 6) ☐ Other: _____

DETAILED ACTION

Response to Amendment

This Office Action is in response to Applicant's amendment received July 21, 2003.

Claims 1-12 are pending in the present application.

Response to Arguments

Applicant's arguments, see page 10, filed July 21, 2003, with respect to the rejection(s) of claim(s) 1-12 under 35 USC 103 have been fully considered, but they are not persuasive.

Applicant argues that Cree fails to teach or suggest positioning control information as required in each of independent claims 1, 5, and 9. While Cree alone does not explicitly teach this limitation, it does not place the application in condition for allowance because the **combination** of Applicant's admitted prior art and Cree teaches this limitation as specified in the rejection of claims 1, 5, and 9.

Claims 2-4, 6-8, and 10-12 are dependent upon claims 1, 5, and 9, respectively, therefore are also unpatentable over Applicant's admitted prior art in view of Cree.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted prior art in view of USPN 4,994,985 issued to Cree et al.

(Amended) Regarding claim 1, Applicant's admitted prior art teaches a multi-media E-mail method of transmitting/receiving a multi-media E-mail including information objects comprising at least one of various types of media information and positioning control information indicating how the information objects are temporally and/or spatially positioned, said multi-media E-mail method comprising:

receiving the multi-media E-mail from a sender (Specification, page 4, lines 3-10; figure 26);

restoring the received multi-media E-mail by positioning each of the information objects included in the received multi-media E-mail according to the positioning control information included therein (Specification; page 4, lines 10-16); and

storing the information objects included in the received multi-media E-mail as received media information (Specification; page 7, lines 14-24).

Applicant's admitted prior art also teaches receiving incoming mail comprising restored information objects and restored positioning control information indicating the restored information objects are temporally and/or spatially positioned in a form of multi-media E-mail (Specifications; pages 1-8).

However, Applicant's admitted prior art fails to teach: composing a return mail for the restored incoming mail by utilizing the received media information; and transmitting the

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composed return mail back to the sender including all the return information objects and the return positioning control information and excluding of the received information objects.

Cree et al. teach sending a reply email back to a sender, which optionally contains only the information that was not included in the original email (col. 1, lines 35-37; 48-55; col. 2, lines 9-53). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine Applicant's admitted prior art with the teaching of Cree et al. by giving the user an option to include only the information that was not included in the original mail in order to give the user flexibility in managing one's correspondence (col. 2, lines 12-15).

(Amended) Regarding claim 2, Applicant's admitted prior art teaches the multi-media E-mail system according to claim 1,

wherein when composing the mail, the received information objects are divided, and the mail is composed by using divided objects obtained by the division, and wherein when transmitting the return mail, as an alternative to transmitting the divided information objects, division controlling information indicating at where said received media information is divided is transmitted in addition to said multi-media E-mail (Fig. 28).

Applicant's admitted prior art fails to teach the mail being a return mail. Cree et al. teaches composing a return mail (col. 1, lines 35-37; 48-55; col. 2, lines 9-53). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine Applicant's admitted prior art with the teaching of Cree et al. by order to ensure that the receiver will receive synchronized email as that specified by the sender.

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(Amended) Regarding claim 3, Applicant's admitted prior art teaches the multi-media E-mail system according to claim 1, further comprising a step of storing the media information included in the multi-media E-mail to be transmitted as transmitted information objects, wherein in said step of restoring the incoming mail by positioning the received information objects and said transmitted information objects according to the positioning control information included in the multi-media E-mail (page 4, lines 6-16; page 7, lines 15-23).

(Amended) Regarding claim 4, Applicant's admitted prior art teaches the multi-media E-mail system according to claim 3, wherein when restoring the incoming mail, the transmitted information objects are divided according to division controlling information included in the received multi-media E-mail, and the incoming mail is restored by using the divided information objects obtained by the division (page 4, lines 6-16). Applicant's admitted prior art fails to teach the mail being a return mail. Cree et al. teaches composing a return mail (col. 1, lines 35-37; 48-55; col. 2, lines 9-53). At the time the invention was made, it would have been obvious to one of ordinary skill in the art to combine Applicant's admitted prior art with the teaching of Cree et al. by order to ensure that the receiver will receive synchronized email as that specified by the sender.

Regarding claim 5, this is a multimedia e-mail device version of claim 1, wherein all limitations as well as motivations are cited in the same area as stated above.

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Regarding claim 6, this is a multimedia e-mail device version of claim 2, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 7, this is a multimedia e-mail device version of claim 3, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 8, this is a multimedia e-mail device version of claim 4, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 9, this is a recording medium version of claim 1, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 10, this is a recording medium version of claim 2, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 11, this is a recording medium version of claim 3, wherein all limitations as well as motivations are cited in the same area as stated above.

Regarding claim 12, this is a recording medium version of claim 4, wherein all limitations as well as motivations are cited in the same area as stated above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alina N Boutah whose telephone number is (703) 305-5104. The examiner can normally be reached on Monday-Friday (8:30 am-5:30 pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (703) 308-5221. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

ANB



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100